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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,805	09/24/2003	Maurice Valen	IMP-102	4324
69597 7590 09/23/2008 MAXINE BARASCH & ASSOCIATES, PLLC 18 CORPORATE WOODS BOULEVARD ALBANY, NY 12211				
EXAMINER				
EIDE, HEIDI MARIE				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
09/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/668,805

**Applicant(s)**

VALEN, MAURICE

**Examiner**

HEIDI M. BASHAW

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 30-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Appendix I

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 30-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw 5,261,818 in view of Kumar 6,364,662.
3. Shaw teaches a tool bit for preparing an osteotomy in a jawbone comprising a longitudinal, rotatable shaft having a proximal end and a distal end, a mounting shank disposed at the proximal end of the longitudinal, rotatable shaft for interfacing with a handpiece of an osteotomy cutting and drilling system, a cutting and drilling portion axially aligned with and disposed at the distal end of the longitudinal rotatable shaft and comprising a osteotomy locator tip 14 comprising dual lobes disposed in a common plane, formed at a distal end of the cutting and drilling portion, a lateral redirector portion comprising cutting edges disposed in a common plane, axially aligned with and disposed adjacent the osteotomy locator tip and a crestal bone height reducing portion disposed intermediate the lateral redirector portion and the longitudinal rotatable shaft. As to claims 33 and 44 Shaw further teaches an osteocompressive portion 16 axially aligned with and disposed intermediate the longitudinal, rotatable shaft and cutting and drilling portion. As to claims 34-35 and 42-43, Shaw also teaches a tapered countersink axially aligned with and disposed intermediate the osteocompressive portion and the

cutting and drilling portion wherein the tapered countersink further comprises a gross osseous crestal bone height reducer. As to claim 38, Shaw further teaches a linking member axially aligned with and disposed intermediate the osteocompressive portion and the end of the rotatable shaft and wherein the mounting shank includes a chuck comprising a generally I-shaped flat side and a generally semicircular disk above and adjacent to a generally semicircular groove (see appendix I for further explanation). As to claims 32 and 36, Shaw does not teach the specific dimensions of the different claimed portions including the lateral redirector, crestal bone height reducing portion, tapered countersink and the osteocompressive portion, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the different portions of specific size since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)). Shaw does not teach the crestal bone height reducing portion and the lateral redirector portion comprising multifaceted serrated cutting edges and wherein the cutting and drilling portion along with the linking member is coated with a material to reduce the coefficient of friction and improve wear and corrosion resistance. Kumar teaches serrated cutting edges as illustrated in fig. 7 and a coating on the cutting and drilling portion along with on the linking member to reduce the coefficient of friction (col. 8, ll. 24-42). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shaw in view of Kumar in order to facilitate in the insertion and removal of the bit as taught by Kumar (col. 8, ll. 40-42) and as a matter of obvious design choice.

***Allowable Subject Matter***

4. Claim 29 is allowed.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. BASHAW whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Bashaw**  
**Examiner**  
**Art Unit 3732**

**/John J Wilson/**  
**Primary Examiner**  
**Art Unit 3732**

/Heidi M Bashaw/  
Examiner, Art Unit 3732  
9/16/2008

Appendix I

